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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/994,014	11/27/2001	Kyoji Saito	P20707	9427

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EXAMINER	
LETT, THOMAS J	

ART UNIT	PAPER NUMBER
2625	

DATE MAILED: 04/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/994,014	SAITO, KYOJI	
	Examiner	Art Unit	
	Thomas J. Lett	2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *06 February 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-12* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-12* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *27 November 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 06 February 2006 have been fully considered but they are not persuasive. Although the prior art of Fujuki (USPN 6,542,254) does not specifically teach of a device having a stop button, Fujuki discloses a control panel having function keys that would allow a user to manually disconnect the connection to the service provider as well as halt email communication. As disclosed at col. 5, lines 26-40, Fujuki teaches that when the user attempts to send facsimile data (step S5), email reception is terminated and the connection to the service provider is terminated (step S7). By manually using control panel (keypad) 5 a user can transmit facsimile data (col. 5, lines 10-14), which would terminate ISP connectivity. The keypad 5 contains function keys (which are programmable) for operating the facsimile device (col. 4, lines 12-15). Wang is relied upon for the function of stopping communication and this functionality combined with a function key of Fujiki would read on claims 1 and 8.

2. With respect to claims 7 and 10, Sekiguchi teaches of a fax device 1-11 containing a CPU 10-3 that receives header information from a server 1-10 regarding the size or 'Mail Data Amount' of an email message. The 'Mail Data Amount' is not an email message that is received, but information data that describes the email prior to being received. The CPU 10-3 determines if information in the header is agreeable (e.g., having sufficient memory space as compared with the 'Mail Data Amount') prior to receiving the email message and is thus able to filter/block retrieval of the email message.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-6, 8, 9, 11, and 12 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicant claims a stop button that disconnects the connection to the service provider without waiting for the completion of email reception, and without performing another communication. Once the service provider has been disconnected, it is understood that another communication will not be performed until the connection is re-established. Applicant does not disclose on p8, paras. 0032-0036 that another communication is not performed. It is also not understood why a machine designed for communication would not perform another communication.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 7 and 10 are rejected under 35 U.S.C. 102(e) as being anticipated by Sekiguchi (USPN 6,898,627 B1).

With respect to claim 7, Sekiguchi disclose a dial-up Internet facsimile apparatus (email/fax machine 1-11 with a block diagram in Fig. 11), comprising:

a modem section (line interface 10-6 includes a modem, col. 4, lines 21-22) that makes a dial-up connection to a service provider of e-mail via a telephone line;

an e-mail reception section (CPU 10-3 receives information data indicative of emails stored on server 1-10 which include 'Mail Data Amount', col. 7, lines 45-56) that receives a size of e-mail data ('Mail Data Amount') from the service provider before receiving the e-mail data, and

eliminates e-mail over a predetermined size from e-mails to be received (CPU 10-3 puts "delete requested" in DELETE MODE 3-12, so that a data delete request associated with the e-mail data 1 is sent to the e-mail server 1-10 in step 2-8 to delete email messages from the email server 1-10, col. 10 , lines 16-21. Examiner notes that the apparatus can filter wanted/unwanted emails based on the information data retrieved from the server 1-10.

With respect to claim 10, Sekiguchi disclose a method for receiving e-mail data, comprising:

making dial-up connection (using a line interface 10-6 that includes a modem, col. 4, lines 21-22) to a service provider of e-mail via telephone line;

receiving a size of e-mail data from the service provider before receiving the e-mail data eliminating e-mail over a predetermined size from e-mails to be received (CPU 10-3 receives information data indicative of emails stored on server 1-10 which include 'Mail Data Amount', col. 7, lines 45-56), and

receiving the e-mail data that is not eliminated from the e-mail data to be received from the service provider (CPU 10-3 puts "delete requested" in DELETE MODE 3-12, so that a data delete request associated with the e-mail data 1 is sent to the e-mail server 1-10 in step 2-8 to delete email messages from the email server 1-10, col. 10 , lines 16-21. Examiner notes that the apparatus can filter wanted/unwanted emails based on the information data retrieved from the server 1-10).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 1-5, 8, 9, 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fujuki (USPN 6,542,254 B1) in view of Wang (USPN 5,757,891).

With respect to claim 1, Fujuki discloses a dial-up Internet facsimile apparatus, comprising:

a modem (data modem 12, col. 3, lines 28-30) that makes a dial-up connection to a server provider of e-mail via a telephone line;

an operation section (keypad 5 containing function keys for enabling operation of the fax device, col. 4, lines 11-14); and

an e-mail reception section (facsimile device F, col. 4, lines 39-42) that receives e-mail data from the connected service provider (col. 5, lines 9-10) and while receiving the email e-mail data, disconnects the connection to the service provider (in Step 8, the connection with the ISP is disconnected and email reception is interrupted, col. 5, lines 26-34) without waiting for the completion of the e-mail data reception (step S7).

Fujuki does not disclose expressly a stop button. Wang discloses an interrupt button 56 that is used to interrupt E-mail communication (col 6, lines 47-48). Fujuki and Wang are analogous art because they are from the similar problem solving area of email reception. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to add the interrupt button feature of Wang to the keypad 5 function keys of Fujiki in order to obtain a device with an interrupt/stop button function. The motivation for doing so would be to interrupt communication using a stop button.

With respect to claim 2, Fujuki discloses a dial-up Internet facsimile apparatus according to the claim 1, wherein said e-mail reception section receives the e-mail data by a message unit (email reception from a server when connected to the ISP, col. 5, lines 9-10).

With respect to claim 3, Fujuki discloses a dial-up Internet facsimile apparatus according to claim 1, wherein said e-mail reception section, when receiving the e-mail data from the service provider, detects whether the e-mail data is the one that was disconnected while being previously received (if there are remaining emails to be retrieved, the process returns to Step S4 to retrieve the unretrieved emails, col. 5, lines 19-22).

With respect to claim 4, Fujuki discloses a dial-up Internet facsimile apparatus, comprising:

a modem (data modem 12, col. 3, lines 28-30) that makes a dial-up connection to a service provider of e-mail via a telephone line;

an operation section that has a stop button (keypad 5 containing function keys for enabling operation of the fax device, col. 4, lines 11-14), and

an e-mail reception section (facsimile device F, col. 4, lines 39-42) that receives e-mail from the connected service provider (col. 5, lines 9-10) and while receiving the e-mail data, interrupts the reception of the e-mail data from the service provider without waiting for the completion of the e-mail data reception (in Step 8, the connection with the ISP is disconnected and email reception is interrupted, col. 5, lines 26-34), said reception section proceeding to the reception of the next e-mail data after the interrupted e-mail data (if there are remaining emails to be retrieved, the process returns to Step S4 to retrieve the unretrieved emails, col. 5, lines 19-22).

Fujuki does not disclose expressly a stop button that, when the stop button. Wang discloses an interrupt button 56 that is used to interrupt E-mail communication

(col 6, lines 47-48). Fujuki and Wang are analogous art because they are from the similar problem solving area of email reception. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to add the interrupt button feature of Wang to the keypad 5 section of Fujiki in order to obtain a device with an interrupt/stop button function. The motivation for doing so would be to interrupt email communication using a stop button.

With respect to claim 5, Fujuki discloses a dial-up Internet facsimile apparatus according to claim 4, wherein said e-mail reception section sets a flag when the e-mail reception is interrupted (if there are remaining emails to be retrieved, the process returns to Step S4 to retrieve the unretrieved emails, col. 5, lines 19-22). Examiner notes that it is obvious that a flag is set if the program initiates a return to Step S3 (see Fig. 2) to retrieve emails that weren't downloaded to the facsimile apparatus F.

Claim 8 is a method claim and is rejected for the same reasons as claim 1.

Claim 9 is a method claim and is rejected for the same reasons as claim 4.

With respect to claim 11, Fujuki discloses a dial-up Internet facsimile apparatus according to claim 1,

wherein the receiver disconnects the connection without regard to progress of the e-mail data reception (in Step 8, the connection with the ISP is disconnected and email reception is interrupted, col. 5, lines 26-34).

Claim 12 is a method claim and is rejected for the same reasons as claim 11.

6. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fujuki (USPN 6,542,254 B1) in view of Wang (USPN 5,757,891) and further in view of Sekiguchi (USPN 6,898,627 B1).

With respect to claim 6, Fujuki in view of Wang do not disclose expressly disclose a dial-up Internet facsimile apparatus comprising an error notification section that transmits an error notification mail to the sender of the e-mail data when the e-mail reception is interrupted Sekiguchi teaches a notification of unsuccessful communication (Fig. 2 uses ACK/NACK method to indicate successful transmission of messages).

Fujuki and Wang are analogous art because they are from the similar problem solving area of email communication. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to add the acknowledgement feature of Sekiguchi to Fujiki in view of Wang in order to obtain a device with a failure notification capability. The motivation for doing so would be to inform a sender that an email was not retrieved from the server.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas J. Lett whose telephone number is (571) 272-7464. The examiner can normally be reached on 7-3:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K. Moore can be reached on (571) 272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TJL TJL

MARK WALLERSON
PRIMARY EXAMINER